



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/377,522	8/20/99	Paul	1012/6003015

EXAMINER	
Fox	
ART UNIT	PAPER NUMBER
1638	20

DATE MAILED:

INTERVIEW SUMMARY

All participants (applicant, applicant's representative, PTO personnel):

(1) Gary Gershik (3) David Fox
(2) Dr. Robert Defader (4)

Date of Interview 10/2/02

Typ: ☒ Telephonic ☐ Personal (copy is given to ☐ applicant ☐ applicant's representative).

Exhibit shown or demonstration conducted: ☐ Yes ☒ No If yes, brief description:

Agreement ☐ was reached. ☒ was not reached.

Claim(s) discussed: All

Identification of prior art discussed: of record

Description of the general nature of what was agreed to if an agreement was reached, or any other comments: Appl rep queried merits of 102 and 103. Examiner pointed out that AP3/PF dimer taught by Krizek et al, was explicitly claimed in ^{instant} claims 7 and 21, so that Applicant's prior assertions, that this embodiment was not desirable, were not persuasive. - continued on attachment
(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

1. ☐ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary. A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a response to the last Office action has been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

2. ☐ Since the Examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the interview unless box 1 above is also checked.

Examiner Note: You must sign this form unless it is an attachment to another form.

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(paper No. 20).

Continuation of Interview Summary, Applicants' representatives conceded, and moved on to query merits of 103 rejection. Examiner informed Applicants' representatives that Mr. Gershik, the attorney of record, had already argued this point in the first interview after final, granted by the Examiner on 11 September 2002, and that further rehashing of these arguments would not be appropriate at this stage of the prosecution. The Examiner indicated today, as he had to Mr. Gershik on 11 September 2002 and in writing, that the claim breadth merited the 103, according to *In re Lindner*. See page 4 of the final Office action of 17 June 2002 (paper No. 16) and the first interview summary, paper No. 19.

Applicants' representatives then asked what the Examiner thought was the strongest subject matter. The Examiner indicated that subject matter drawn to the dimerization of RNA ase genes such as the exemplified Barnase or RNAaseA genes, and their use in tissue ablation in transformed plants to cause male sterility (pages 21-35 of the specification, examples 1-3), appeared to be the most supported. However, as this subject matter was non-elected by Applicants as corresponding to non-elected Species II, and therefore not searched by the Examiner nor evaluated for compliance under 35 USC 112 first or second paragraphs, it would not be appropriate for the Examiner to commit to its patentability at this stage in the prosecution.

Applicants' representatives then queried as to the appropriateness of this characterization of the elected invention. The Examiner pointed Applicants' representatives to page 2 of the Restriction Requirement of 13 December 2000 (paper no. 8), where Group I was drawn to the splitting of genes encoding functional enzymes involved in carbohydrate biosynthesis in vegetative

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or storage organs, Group II was drawn to splitting of genes conferring male sterility, including barnase; and Group III was drawn to splitting of genes conferring seedless or embryo-less fruit.

The Examiner further directed Applicants' representatives to Applicants' response of 17 January

2001, Paper No. 9, where Applicants elected Group I with traverse (page 2, bottom) and urged

that an election of species requirement would be more appropriate (page 3, second full

paragraph). The Examiner further directed Applicants' representatives to the Office action of 23

March 2001, paper no. 11, page 2, where the Examiner recast the previous restriction

requirement as an election of species, while maintaining the same separations of subject matter,

and on page 3, penultimate paragraph, where the Examiner stated that he understood Species I to

be constructively elected by Applicants, based upon their previous election of corresponding

Group I. The Examiner then directed Applicants' representatives to their response of 27 August

2001, paper no. 12, pages 5-6, where Applicants acknowledged the election of species

requirement and the examiner's understanding of their election, and where Applicants then stated

that the generic claim (corresponding to Species I) was allowable, but where Applicants did not

dispute the Examiner's examination of Species I or his withdrawal of Species II. The Examiner

then directed Applicants to the Office action of 26 November 2001, page 2, where he indicated
(paper no. 14)

that additional claims (submitted by a supplemental amendment of 21 September 2001) directed

to splitting of barnase genes, corresponded to non-elected Species II and were thereby withdrawn

from consideration. Applicants are further directed to their response of 4 April 2002, penultimate
(paper no. 15)

paragraph of page 10 and paragraph bridging pages 10 and 11, where they admit that the newly

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added claims (corresponding to Species II) were non-elected, but that their amendments to the elected claims resulted in their allowability, so that the non-elected claims (corresponding to splitting barnase genes) should now be examined.

Thus, the record was clear regarding the elected invention, Applicants' current protestations notwithstanding. Applicants were invited by the Examiner to petition the Group Director as to the merits of the election of species requirement. However, Applicants were notified that the Examiner would not use the instant interview to discuss the merits of the election of species requirement.

DAVID T. FOX
PRIMARY EXAMINER
GROUP ~~180~~ 1638

A handwritten signature in black ink, appearing to read "David T. Fox", followed by a large, stylized flourish or checkmark.



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EXAMINER

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INTERVIEW SUMMARY

All participants (applicant, applicant's representative, PTO personnel):

(1) Gary Gershik (3) _____
(2) David Fox (4) _____

Date of Interview 9/11/02

Type: ☒ Telephonic ☐ Personal (copy is given to ☐ applicant ☐ applicant's representative).

Exhibit shown or demonstration conducted: ☐ Yes ☒ No If yes, brief description: _____

Agreement ☐ was reached. ☒ was not reached.

Claim(s) discussed: All

Identification of prior art discussed: of record

Description of the general nature of what was agreed to if an agreement was reached, or any other comments: App rep disputed the "regulatory protein" was indefinite, and urged that AP3 and P. dimer example was stated in spec to be of no use in intent invention. The Exam could not find that disclaimer in the Examples. Appl rep indicated intent to amend claims to recite "transcription factor" in lieu of "regulatory protein". Exam could be found in spec, or to add dependant claims to "regulatory protein". Appl rep urged that 103 lacked motivation to combine ref. Exam maintained that claim breadth warranted 103 per Lindner. Exam indicated that limiting claims to exemplified genes would overcome 103. Appl rep indicated intent to
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FORM PTOL-413 (REV.1-96)

explore narrowing scope of claims somewhat. No commitment to patentability, or to entry of subsequent after final amendments was made. Replied 11/11

Manual of Patent Examining Procedure, Section 713.04 Substance of Interview must Be Made of Record

A complete written statement as to the substance of any face-to-face or telephone interview with regard to an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview.

§1.133 Interviews

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for response to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

§ 1.2. Business to be transacted in writing. All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete a two-sheet carbon interleaf Interview Summary Form for each interview held after January 1, 1978 where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks in neat handwritten form using a ball point pen. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below.

The Interview Summary Form shall be given an appropriate paper number, placed in the right hand portion of the file, and listed on the "Contents" list on the file wrapper. The docket and serial register cards need not be updated to reflect interviews. In a personal interview, the duplicate copy of the Form is removed and given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephonic interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the telephonic interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Serial Number of the application
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (personal or telephonic)
- Name of participant(s) (applicant, attorney or agent, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the claims discussed
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). (Agreements as to allowability are tentative and do not restrict further action by the examiner to the contrary.)
- The signature of the examiner who conducted the interview
- Names of other Patent and Trademark Office personnel present.

The Form also contains a statement reminding the applicant of his responsibility to record the substance of the interview.

BEST AVAILABLE COPY

It is desirable that the examiner orally remind the applicant of his obligation to record the substance of the interview in each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check a box at the bottom of the Form informing the applicant that he need not supplement the Form by submitting a separate record of the substance of the interview.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview:

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner. The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he feels were or might be persuasive to the examiner,
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete or accurate, the examiner will give the applicant one month from the date of the notifying letter or the remainder of any period for response, whichever is longer, to complete the response and thereby avoid abandonment of the application (37 CFR 1.135(c)).

Examiner to Check for Accuracy

Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview. If there is an inaccuracy and it bears directly on the question of patentability, it should be pointed out in the next Office letter. If the claims are allowable for other reasons of record, the examiner should send a letter setting forth his or her version of the statement attributed to him. If the record is complete and accurate, the examiner should place the indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.